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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1934

No. 588

THE STELOS COMPANY, INC.,

Petitioner,

vs.

HOSIERY MOTOR-MEND CORPORATION,
KAYSER HOSIERY MOTOR-MEND CORPORATION,
JULIUS KAYSER & COMPANY, A CORPORATION,

Respondents.

PETITION FOR CERTIORARI

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

The petition of The Stelos Company, Inc., a corporation organized and existing under the laws of the State of Delaware, respectfully prays the issue of a writ of certiorari to review the opinion of the Circuit Court of Appeals for the Second Circuit in the case and subject-matter now to be described. The transcript of record, including the proceed-

ings in the Circuit Court of Appeals, is filed herewith, pursuant to Rule 38.

Summary Statement of Matters Involved

On the 5th day of February, 1929, a patent infringement suit in the usual form was filed in the United States District Court for the Southern District of New York, against Hosiery Motor-Mend Corporation, by The Stelos Company, Inc. It alleged infringement of reissue patent No. 16,360, (R. 961) issued to The Stelos Company, Inc., as assignee of Frank C. Stephens. Claim 23 only of the patent was involved in the suit.

Subsequently, on the 16th day of July 1930, Kayser Hosiery Motor-Mend Corporation and Julius Kayser & Company, a corporation, were joined as defendants. The original defendant, Hosiery Motor-Mend Corporation, and the additional defendants, Kayser Hosiery Motor-Mend Corporation and Julius Kayser & Company, a corporation, are hereinafter called the defendants. The Stelos Company, Inc., is hereinafter called the plaintiff or the petitioner.

Upon proof in open court, District Judge, the Honorable John M. Woolsey, held claim 23 of the patent in suit invalid and not infringed, and dismissed the Bill of Complaint. Plaintiff appealed to the Circuit Court of Appeals for the Second Circuit. On July 31, 1934, the Circuit Court of Appeals filed an opinion reversing the decree of the District Court so far as it declared claim 23 invalid, but affirming the decree of the District Court so far as it dismissed the Bill of Complaint for non-infringement. Plaintiff filed a petition for rehearing which was entertained, but was denied on October 26th, 1934. On October 26th, 1934, a mandate was issued from the Circuit Court of Appeals for the Second Circuit to the District Court, but a decree of the District Court signed November 23, 1934, provided for a stay of execution in contemplation of this application for a

writ of certiorari. The opinion of the District Court is at R. 1266, and in 60 Fed. (2d) 1009, and the opinion of the Circuit Court of Appeals for the Second Circuit is in 72 Fed. (2d) 405. (R. 1341.)

In order that this Honorable Court may understand the grounds on which this petition for a writ of certiorari is based, the following statement of facts, condensed from the opinion of the Circuit Court of Appeals for the Second Circuit is submitted:

> "The invention is for a method of repairing 'runs' in a stocking or the like. The fabric is stretched over a hollow holder like a cup or glass; a hook with a pivoted latch is then put through a loop of the 'run' until the loop has slipped past the end of the latch, which it has meanwhile opened in its passage. The hook is then drawn back catching the next thread of the run, and by the same movement the first loop closes the latch, which with the hook embraces the caught thread, the first loop sliding off the closed latch. The caught thread can then be moved over the first loop to make a second loop, and will open the latch as the hook descends to catch a second thread with which to make a third loop. This process will be so repeated to the end of the run.
>
> "The infringement is by a similar needle except that the latch slides to and fro longitudinally in the shank, instead of being pivoted."

The patent in suit disclosed only a manual operation of plaintiff's run repairing needle; the defendants operate their needle mechanically, although guided by the hand of the operator. However, it is conceded that there is no distinction between the machine-operated needle and a manually operated needle. In fact in starting and finishing the runs defendants operate their needles by hand. The Circuit Court of Appeals for the Second Circuit held that infringement was not avoided by use of a sliding latch needle instead of the pivoted latch needle of the patent.

Defendants assert that in their method of repairing runs the needle is always held in a vertical plane normal to the plane of the fabric, i. e., perpendicular to the run but this is denied by plaintiff.

The opinion of the Circuit Court of Appeals for the Second Circuit, turned on the interpretation of the clause in the claim: "laterally out of alignment with the run". The Court of Appeals of the District of Columbia, decided in effect that the repairing instrument held at any angle to the run, i. e., non-parallel with the run itself, was "laterally out of alignment with the run",

The Circuit Court of Appeals for the Second Circuit construed this clause to mean off at one side of the run, and that an instrument operated in a plane longitudinally with, and perpendicular to, the run, would not infringe the method claim.

If the Circuit Court of Appeals for the Second Circuit was correct in its interpretation of the clause "laterally out of alignment", its conclusion was erroneous, we submit, because plaintiff was entitled to a range of equivalents with respect thereto. On the other hand, if the Circuit Court of Appeals for the Second Circuit was not correct in its interpretation, we submit that its decision should be reversed.

Prior to Stephens' invention, the only repairing of hosiery was done in a few scattered hosiery mills by a tedious eye-straining method, known as the "finger method" in which the needle was worked along the surface of the run while the fabric was stretched over the operator's finger. Stephens made a radical departure from this slow tedious, eye-straining method of repair over the finger and created a touch method in which the needle worked *through the fabric instead of along the surface* and it was this punching through the fabric while stretching the fabric and manipu-

lating it over a holder such, for instance, as an egg cup, that constituted the gist of his invention and distinguished it essentially from the prior "finger method". It was this new method of operating the needle which removed all of the eye strain and greatly speeded up the work, and resulted in a new national industry.

From 1925 to 1928, plaintiff sold franchises under this patent to the extent of $658,000.00 in various parts of the United States in addition to establishing quite a large business in the mending of hosiery, (R. 168-169). As an instance of the business carried on under this method, Eastern Stelos Company, one of the franchise holders, from 1926 to 1930, did a total business in hosiery repair service of $370,000.00 (R. 187). This new and much needed industry employed hundreds of girls at good wages, many of whom were physically disqualified for usual gainful occupations, such as cripples, deaf mutes, and the like.

Reasons Relied Upon for Granting Certiorari

Upon this statement of facts and the record in the cause, the petitioner is advised by its counsel and, therefore, alleges that the opinion of the Circuit Court of Appeals constitutes a decision in conflict with a decision of another United States Court of Appeals, and constitutes a decision of Federal (patent) law in a way probably in conflict with applicable decisions of this Court and with the weight of authority,—all in the particulars specified in the following paragraphs. The particulars in support of each allegation and the development of its importance and controlling effect upon the decision, and the reasons why the decision should to that extent be reviewed by certiorari, are stated in the accompanying brief, as specified in each such paragraph:

First. The question of infringement of claim 23 of the patent in suit, as decided by the Circuit Court of Appeals

for the Second Circuit, was in direct conflict with the opinion of the Court of Appeals of the District of Columbia in which substantially the same device and the same method of operation were involved, the difference in opinion being the result of a difference in interpretation of claim 23 of the patent in suit. (See Brief, p. 15, *infra*.)

Second. The decision was erroneously to the effect that the clause in claim 23 "while holding the device laterally out of alignment with the run" restricts the claim to the holding of the device off to one side of the run. (See Brief, pp. 15-17, *infra*.)

Third. The decision was erroneously to the effect that the method of claim 23 of the patent in suit differed from the method of cancelled claim 10 of the Stephen application only by reason of the clause "while holding the device laterally out of alignment with the run", which clause became essential to an infringement, an element with which the doctrine of equivalents would not allow the patentee to dispense. (See Brief, pp. 17-19, *infra*.)

Fourth. The opinion, erroneously interpreting and applying the decision of this Honorable Court in Smith vs. Magic City Kennel Club, 282 U. S. 784, 790, in effect held that a non-essential element, added in a new claim after the filing of the application for the patent which was not an element of the claims in the application as filed, became essential to an infringement and the doctrine of equivalency would not apply with respect thereto. (See Brief, pp. 19-22, *infra*.)

Further Question Presented

Petitioner respectfully presents the foregoing paragraphs as its specification of the particulars in which the decision was of a character entitling petitioner to the issuance of a writ of certiorari, under the provisions of Rule 38 of this

Court. It also presents a further and specific reason why the judgment of the Circuit Court of Appeals should be reversed, if a writ of certiorari is allowed:

Fifth. The Court was in error in holding that claim 23 was not infringed, although the evidence shows that, according to the interpretation of claim 23 by the Circuit Court of Appeals, the defendants indubitably do infringe the claim.

Wherefore, the petitioner respectfully prays that a writ of certiorari may be granted by this Court, directed to the Circuit Court of Appeals for the Second Circuit, to review the decision of that Court in the case numbered and entitled on its docket, No. 458, The Stelos Company, Inc., Plaintiff-Appellant, vs. Hosiery Motor-Mend Corporation, Kayser Hosiery Motor-Mend Corporation, and Julius Kayser & Company, a corporation, Defendants-Appellees; and that this petitioner may have such other and further relief in the premises as to this Honorable Court may seem just—and your petitioner will ever pray.

VERNON E. HODGES,
HENRY GILLIGAN,
J. PRESTON SWECKER,
Counsel for Petitioner.

Washington, D. C.,
December 20, 1934.

BRIEF IN SUPPORT OF ACCOMPANYING PETITION FOR CERTIORARI

The Opinion Below

The opinion of the District Court (by Judge Woolsey) is in the Record, p. 1266. The opinion of the Circuit Court of Appeals (by Circuit Judge Learned Hand) is found in 72 Fed. (2d) 405 (R. 1341).

The Jurisdiction of the Court

The opinion sought to be reviewed was entered by the Circuit Court of Appeals for the Second Circuit on July 31, 1934, (petition for rehearing denied October 26th, 1934). The reviewing power of this Court is invoked under Section 240 (a) of the Judicial Code, as amended, and as applied and developed by Rule 38 of this Court. The willingness of this Court to exercise this power in patent cases where there is diversity of opinion on the same matter of infringement in different Circuits, although the validity of the patent is not in question, appears to be well settled by the cases of Sanitary Refrigerator Co. vs. Winters et al, 280 U. S. 30; Weber Electric Co. vs. Freeman Electric Co., 256 U. S. 668; I. T. S. Rubber Co. vs. Essex Rubber Co., 272 U. S. 429; Smith vs. Magic City Kennel Club, 282 U. S. 784; and Keller vs. Adams-Campbell Co., Inc., 264 U. S. 314.

The opinion of the Circuit Court of Appeals for the Second Circuit on the question of infringement is in direct conflict with the opinion of the Court of Appeals of the District of Columbia, where approximately the identical infringing process was considered in Finch Corporation vs. The Stelos Company, 46 Fed. (2d) 606, but the Circuit Court of Appeals for the Second Circuit expressly disagreed with the conclusion reached by the Court of Appeals of the Dis-

trict of Columbia as to the construction of claim 23. (72 Fed. (2d) 405, 406.)(R.1344).

The validity of claim 23 has been consistently sustained not only by the Circuit Court of Appeals for the Second Circuit in this case and by the Court of Appeals of the District of Columbia in Finch Corporation vs. The Stelos Company, Inc. but also, it was sustained in the cases of The Stelos Company vs. Gearhart (D. C. Pa.), 60 Fed. (2d) 1006; The Stelos Company vs. Green-Jac Sales Company (D. C. Mo., E. Div.); and The Stelos Company vs. Stark (D. C. Mo., W. Div.). In the last three mentioned cases, pivoted latch needles were involved, but in the Finch case the same sliding latch needle was involved as is used by defendants in this case. Also, Finch claimed to have held the needle in the vertical plane of the run, in the same position in which defendants claim to use their needles.

The point of difference of opinion between the Circuit Court of Appeals for the Second Circuit and the Court of Appeals of the District of Columbia concerned the clause of claim 23, namely, "holding the device laterally out of alignment with the run".

Statement of the Case and Specification of Errors

The general facts are sufficiently stated in the petition (pp. 2-5, *supra*) and the errors relied upon are set out, in general terms, in paragraphs *First—Fourth* (pp. 5-6, *supra*). The more detailed facts thought important, and a fuller explanation of our claims of error, are found in the argument hereafter made.

Argument

Before discussing the principal points of the errors relied upon, it may be helpful to explain the invention somewhat more in detail.

The Patent in Suit

The Stephens reissue patent appears in the Record, at pages 961 to 965.

In considering the subject-matter of the Stephens patent, it should be borne in mind that the Stephens method was devised as an improvement on the finger method previously used by Mrs. de Marr, in Mexico, and by others, such as is represented in the de Marr application (R. 1204).

In the finger method used by Mrs. de Marr, the fabric was stretched over the operator's finger and the hook of the needle picked up the threads and formed them into loops by working along the surface or over the top of the run as shown in the drawings, particularly Fig. 4, of the de Marr application. (R. 1204.)

When the Stephens application was filed, a clear distinction was pointed out in the specification between the invention of Stephens and the old finger method used by Mrs. de Marr, a portion of which, appearing on page 1, of the Stephens patent (R. 962), lines 3 to 14, inclusive, and 58 to 78, inclusive, is as follows:

> "In repairing the runs or ravels in knitted goods, other needles have been used, but they are not practical, as the method of use is a tedious one, and trying both to the eyes and patience of the operator. In other methods, the fabric is stretched over the finger tip, making it difficult to insert the hook beneath the thread. This objection is obviated in the present invention by stretching the fabric over a porcelain dish, allowing sufficient depth for the free use of the needle.
>
> * * * * * *
>
> "With other needles and their method of use it is necessary to insert the hook into the first loop of the fabric to be repaired. This also applies where the partially repaired work has been slipped from the

needle. With my invention and its method of use, the hook can be inserted at any point back of the running loop and the fabric run back to the loop that has been picked up. This makes it unnecessary to pick up a certain loop as must be done with other needles.

"With other needles and their method of use, care must be used to see that each separate thread is picked up by the hook. This places a strain on the eyes. With my needle and its method of use this is not necessary as it is possible to pick up the threads faster than the eye can see the operation and therefore places no strain on the eyes."

One of the most important distinctions between the Stephens method and the prior finger method was the manner of working *through the fabric* with the needle inclined out of alignment with the run, or out of parallel with the surface, which obviated the difficulty encountered in attempting to pick up the threads where the fabric was stretched over the finger and the needle operated over the surface of the run. The patent states that such manner of use as had been practiced by Mrs. de Marr prevented the needle from being inserted beneath the threads, but the Stephens invention obviated this objection "by stretching the fabric over a porcelain dish, *allowing sufficient depth for the free use of the needle.*" (Lines 12 to 14, page 1 of the Stephens patent).

The Stephens method of working *through the fabric* is permitted by reason of the fact that the needle is inclined out of alignment with the run during the entire operation and is not swung down to a position parallel with the run as in de Marr.

In carrying out the Stephens method as described in the patent, first there is stretching of the fabric over a suitable holder, such as a cup or porcelain dish, and while stretching the fabric, the needle is inserted in the last loop or back of the last loop and the run extended to the needle by further

stretching the fabric. The operator moves the needle up and down through the fabric, reforming the loops, in the most natural manner and with machine-like speed.

The manner of manipulating the needle of the Stephens punch method is partially illustrated in the respective views of Figs. 4, 5, and 6 of the Stephens patent (R. 961). These figures show exaggerated views of a portion of a run in a stocking, but the fabric is magnified to a greater extent than the needle in order to show as clearly as possible the manner of relooping.

Fig. 4 represents the needle inserted through a loop at or back of the end of the run designated *a*, and since the needle passes down through the fabric at a substantial angle to the horizontal plane of the run, it passes under the next cross thread *b*, as is represented in this Figure. At this time the latch 4 is open, and as the needle is pushed down the loop *a* rides over and gets behind the latch so that when the needle is pulled up, the cross thread *b* will be caught in the hook. At the same time, the backward movement of the needle through the loop *a*, causes the loop *a* to push the latch to a closed position trapping the cross thread *b* in the hook of the needle, while the hook is being pulled through the loop *a*, which thereby forms a new loop *c* (see Fig. 6) in the cross thread *b*. After being pulled through the loop *a* to form the loop *c*, the needle is again pushed down through the loop *c* of the fabric, the loop *c* moving the latch 4 to a fully open position.

The patent describes the magnetizing of the hook and latch sufficiently to repel the latch when it is released by the loop *a* between the positions shown in Figs. 5 and 6, but usually the magnetizing is not sufficient to fully open the latch but merely starts the opening action and the loop *c* moves the latch to a fully open position, as shown in Fig. 4, and at the same time the continued downward movement of the needle through the loop *c* would carry the needle to the

position shown in Fig. 4, where the loop *c* would be behind the latch 4 in the position of the loop *a* in Fig. 4. That would complete the downward stroke of the needle and then it would be pulled up in a reverse direction, and the operation repeated, as described. Finally, after relooping all of the threads, the end loop or thread is fastened to hold the fabric and prevent another run.

Claim 23

Claim 23 of the patent, the only one involved in this suit, is as follows:

> 23. An improved method of repairing runs or ravelings in a fabric which consists in stretching the fabric over a suitable holder, inserting a repairing device having a hook and pivoted latch through a loop formed in the run or raveling, continuing this movement on through the fabric while holding the device laterally out of alignment with the run or raveling until the loop has slid back over the end of the latch and beneath the latter, then reversing the movement of the device through the loop, catching the next forward thread in the hook while the loop is being pulled over the latch causing the latch to close over the thread, and the loop to be cast off over the end of the device, the thread caught in the hook thereupon forming a new loop, taking the place of the first-described loop, then reinserting the device into the fabric as before, and repeating the operation until the run or raveling has been repaired, and finally fastening the thread.

The first step of the process set forth in this claim is the step of "stretching the fabric over a suitable holder," which is *always* done by hand.

Next, the claim recites the insertion of a repairing device (which is really the hook and latch needle) through a loop in the run or raveling and *continuing this movement on through the fabric* while holding the needle laterally out of alignment with the run or inclined at an angle to the plane

of the run, which distinguishes the punch method from the finger method by reason of the substantial angle between the needle and the horizontal plane of the run. In other words, with the finger method the needle would operate along the surface of the fabric as it would be moved back and forth. But in the Stephens method where the needle operates in a punch fashion *through the fabric* as definitely stated twice in the claim it would be raised out of alignment or out of the horizontal plane of the run, and, in fact, at a considerable angle thereto. The claim recites that this movement of the needle continues on through the fabric until the loop has slid back over the latch to a position where it would close the latch when the movement of the repairing device is reversed through the loop.

On this reverse movement the hook of the device catches the next forward thread, such as the thread *b*, in Figs. 4 and 5, and as the reverse movement continues, the loop *a* causes the latch to close over the thread caught in the hook. The reverse movement continues until this loop *a* which has closed the latch is cast off over the end of the needle while the thread *b* has been pulled through that loop *a*, thereby forming a new loop *c*, in Fig. 6. Then the claim recites that the needle is reinserted into the fabric and the operation repeated until the run has been reknit and the thread finally fastened.

In contrast with the Stephens process in which the device works up and down *through the fabric*, the finger method with the needle moved back and forth along the surface of the fabric, is graphically illustrated in the drawings of the de Marr application which illustrate the reciprocation of the needle over the surface of the run. (R. 1204.) *The finger method requires the operator to pick up each thread carefully with a sort of fishing action, which causes an excessive eye-strain, and makes the work very slow and*

tedious, because with the finger method the eyes of the operator can never leave the work for a single instant.

The Opinion of the Circuit Court of Appeals

The point in claim 23 as to which the Circuit Court of Appeals for the Second Circuit disagreed with the Court of Appeals of the District of Columbia was the step of "holding the device laterally out of alignment with the run".

The Circuit Court of Appeals for the Second Circuit stated:

> "The plaintiff says that the clause means no more than that the needle shall be held at a substantial angle to the plane of the fabric, and so it was held by the Court of Appeals of the District of Columbia in Stelos Co. vs. Finch Corp'n., 46 Fed. (2) 606. We cannot agree. * * * the words cannot be read as the plaintiff wishes. If Stephens had meant no more than that the needle should be held at a substantial angle to the fabric, he did not say so." (R. 344 .)

That is certainly what he meant; the expression may have been awkward, perhaps inapt, but it is submitted the court should determine what was meant and construe the claim accordingly. The claim might have been somewhat clearer if it had said "laterally or out of alignment", as alternative expressions meaning the same thing, namely, that the needle is not in the plane of the fabric, but is inclined at a substantial angle to the fabric.

The Court continued:

> "There cannot be the least doubt that the clause meant to exclude just that."

Why should it have meant to exclude it? There was no prior art cited showing the needle vertically in the plane of

the run. The Pogson British patent (publication) (R. 1129) was the only reference mentioned in connection with the method, and whatever this patent was intended to show, counsel for defendants have urged consistently that the clause "laterally out of alignment with the run" is "shown by Pogson", and further that Pogson "shows the needle laterally out of alignment with the run". (Brief before C. C. A.) What did they mean by these statements? If they meant at a substantial angle to the plane of the fabric, as interpreted by the Court of Appeals of the District of Columbia, this shows that defendants' counsel have accepted this as a proper interpretation of the words of the claim. On the other hand, if they meant off to one side of the run, this urging that this feature is shown in Pogson, shows that that could not have been the distinction which carried the claim over the prior art, so as to work an estoppal under Smith vs. Magic City Kennel Club, 282 U. S. 784, 790.

In this connection the Circuit Court of Appeals referred to the guard 5 of the needle (R. 961). The Court suggested that it would "appear easier to hold the needle off to the same side of the fabric that the guard is to the shank; though no doubt it could be done otherwise". This is an erroneous assumption. The guard would have exactly the same effect whether the needle is held off to one side or directly over the run.

The reason for holding the needle off to one side of the run is because it is natural to hold the needle in that position. There is another reason too, the off side relation facilitates the closing of latch 4 over the cross thread and forcing it into the hook, a feature included in original claim 10, but omitted from claim 23. Defendants have attempted to read this limitation into claim 23 because it was in claim 10, but the courts below have consistently refused to give the claim any such construction. Since

claim 23 definitely omitted the clause of original claim 10 "grasping the adjacent thread with the latch forcing it into the hook", it seems clear that the patentee did not intend to be limited to the offside position for holding the needle, which is all the more reason for construing the clause "while holding the device laterally out of alignment with the run" in the sense of *holding it at an angle to the plane of the fabric.*

No Estoppal by Cancelled Claim 10

In this connection the Court referred to claim 10 of the Stephens application which was cancelled after an official action by the Patent Office, in which the Examiner stated:

> "Claim 10 which is drawn to the combination of a method and a specific construction of the needle, is rejected. The invention, if any, resides in the specific element. The alleged method is fully disclosed in Pogson."

Cancelled claim 10, was as follows:

> 10. A method of needle work which consists in stretching a fabric over a suitable holder, and inserting a needle having a *magnetized, curved* hook, a *magnetized, curved* latch or bridge *and a beveled side guard* through the loop of the run or raveling, *grasping the adjacent thread with the latch forcing it into the hook,* pulling the thread through the loop, grasping the next thread *forcing it* into the hook and pulling it through the loop formed, etc., until the run or raveling is repaired.

Original claim 10 was a hybrid method and article claim because it included method steps and structural characteristics of the needle, and it was rejected for this reason.

The real points of difference of limitation in claim 23 over claim 10 are in the steps of claim 23, "continuing this movement on *through* the fabric" and "reinserting the de-

vice *into* the fabric as before". These are the essential differences between the old finger method wherein the needle worked *over the surface* of the fabric and the Stephens punch method where the needle works *through* the fabric, as defined in claim 23, but this was not clearly defined in original claim 10.

Thus we see that the Circuit Court of Appeals for the Second Circuit was in error in stating that the only difference between the two methods of claims 10 and 23 was in the clause "while holding the device laterally out of alignment with the run". That was not the distinction and unless it is given the interpretation urged for it by plaintiff and as held by the Court of Appeals of the District of Columbia, this would not be a distinction from the prior art.

It should be noted that the clause in the claim is more than the part quoted by the Circuit Court of Appeals for the Second Circuit and that the complete clause is "continuing this movement on through the fabric while holding the device laterally out of alignment with the run". When taken as an entirety, it seems clear that this really means the inclination of the needle to the plane of the fabric sufficient to permit the needle to work *through the fabric* in the characteristic fashion of the punch method. This forms the real distinction from the prior art and it should be so construed as to make that difference clear.

Such an interpretation would not be inconsistent with the decision of this Court in Smith vs. Magic City Kennel Club, 282 U. S. 784, 790, which reasserted the well-known rule that where a claim is amended or rewritten in a more restricted fashion, the patentee is estopped from resorting to the doctrine of equivalents to give to the claim the larger scope which it might have had without the amendments. That rule is universally recognized but it doesn't apply here for plaintiff is not trying to give claim 23 a meaning coexten-

sive with cancelled claim 10. Plaintiff is only attempting to give the claim its intended meaning, the meaning which characterized this invention and distinguished it from the prior art, wherein the needle operated through the fabric out of alignment with the run or at a substantial angle to the run. Plaintiff has no intention of trying to excise that distinguishing characteristic of the invention or that clause of the claim because it is a real distinction over the prior art and a real characteristic of the invention.

There is no attempt made here to construe claim 23 as broadly as the method involved in original claim 10, and if it were, defendants would still claim that they do not infringe because they allege that in their process they do not have the step of claim 10 of "grasping the adjacent thread with the latch forcing it into the hook", which was a step in the cancelled claim but is not a step in claim 23. However, they do use the step of claim 23 of "continuing this movement on through the fabric", and that is the real distinction between the claims, which taken with the other steps distinguish plaintiff's punch method from the "finger method" and constitutes the gist of this invention.

Element Added in Claim Not Necessarily Essential to Infringement if It Was Not the Principal Distinction from Prior Art

Even if the clause "laterally out of alignment with the run" is construed as defining a position at one side of the run, as held by the Circuit Court of Appeals, it is submitted that plaintiff is not estopped by cancellation of original claim 10 from invoking the doctrine of equivalents as to this clause in the claim.

The Court of Appeals of the District of Columbia found that an upright position of the needle at right angles to the

plane of the fabric was the equivalent of the position claimed, giving a range of equivalents according to the distinction between the claimed invention and the prior art. **The real distinction, as pointed out above, resides in the punch method through the fabric and that was the principal difference between the methods of claims 10 and 23.**

Such a holding is not inconsistent with the decision of this Court in Smith vs. Magic City Kennel Club, *supra*, the doctrine of which has been well established for a long time. It is equally well established that the doctrine mentioned does not estop the patentee from claiming a fair interpretation of his claim as actually granted. As stated in Hubbell vs. United States, 179 U. S. 77, 80:

> "While not allowed to revive a rejected claim, by a broad construction of the claim allowed, yet the patentee is entitled to a fair construction of the terms of his claim as actually granted."

This principle is also followed in practically all of the Circuit Courts of Appeals in the United States including the Second Circuit, as indicated by the following decisions: Deitel vs. Unique Specialty Corp. (C. C. A. 2) 54 Fed. (2d) 359, 360; Hoe & Co. vs. Goss Printing Press Co. (C. C. A. 2) 30 Fed. (2d) 271, 275; Hess-Bright Mfg. Co. vs. Fichtel (C. C. A. 3) 219 Fed. 723, 727; Standard Brick Co. vs. Denison Interlocking Tile Corp. (C. C. A. 5) 285 Fed. 108, 110; Farrington vs. Haywood (C. C. A. 6) 35 Fed. (2d) 628, 631; Southern Textile Machinery Co. vs. United Hosiery Mills Corp. (C. C. A. 6) 33 Fed. (2d) 862, 866; Frey vs. Marvel Auto Supply Co. (C. C. A. 6) 236 Fed. 916, 921; National Tube Co. vs. Mark (C. C. A. 6) 216 Fed. 507, 522; Eggleston vs. Milwaukee Heater Mfg. Co. (C. C. A. 7) 199 Fed. 147, 151; New York Scaffolding Co. vs. Whitney (C. C. A. 8) 224 Fed. 452, 462; Ottumwa Box Car Loader Co. vs. Christy Box Car Loader Co. (C. C. A. 8) 215 Fed. 362, 373; O'Brien-Worthen Co. vs. Stempel (C. C. A. 8) 209 Fed.

847, 851; Owens Co. vs. Twin City Separator Co. (C. C. A. 8) 168 Fed. 259, 268; Wayne Mfg. Co. vs. Benbow-Brammer Mfg. Co. (C. C. A. 8) 168 Fed. 271, 279; National Hollow Brake-Beam Co. vs. Interchangeable Brake-Beam Co. (C. C. A. 8) 106 Fed. 693, 714; and Angelus Sanitary Can Machine Co. vs. Wilson (C. C. A. 9) 7 Fed. (2d) 314, 318.

One of the early cases on this question which has been referred to in most of the above decisions and followed almost universally, was National Hollow Brake-Beam Co. vs. Interchangeable Brake-Beam Co., *supra*, in which the Court stated:

> "It is true that if a patentee acquiesces in the rejection of his claim on references cited in the Patent Office, and accepts a patent on an amended claim, he is thereby estopped from maintaining that the amended claim covers the combinations shown in the references, and from claiming that it has the breadth of the claim that was rejected. (Cases cited.) *But this is the limit of the estoppal. One who acquiesces in the rejection of his claim because it is said to be anticipated by other patents or references is not thereby estopped from claiming and securing by an amended claim every known and useful improvement which he has invented that is not disclosed by those references.*" (714 of 106 Fed.) (Italics ours).

The Circuit Court of Appeals for the Second Circuit was clearly in error in its conclusion that the clause "while holding the device laterally out of alignment with the run" was the only difference between the methods of claims 10 and 23, which erroneous premise led to an erroneous conclusion, that plaintiff was thereby estopped from any range of equivalents as to that clause. We find in all of the foregoing decisions that a patentee is entitled to a range of equivalents commensurate with his improvements over the prior art, so long as he doesn't attempt to construe the claim as broadly as the claim cancelled during the prosecution of the application.

Here we find that this point of difference "laterally out of alignment with the run" is a point which defendants have consistently urged is disclosed in the prior art, (Pogson), so that it could not have been a distinction and in fact it was not unless interpreted according to the decision of the Court of Appeals of the District of Columbia as meaning inclined to the plane of the fabric to give added meaning to the preceding portion of the clause, "continuing this movement on through the fabric". That is the meaning urged for the clause by plaintiff and it was the meaning intended to be incorporated in the claim at the time it was presented in order to define the Stephens punch method through the fabric and to distinguish from the surface or finger method. When claim 23 was introduced the feature of working at one side of the run was expressly omitted from the claim and it should not be included by implication, which would materially restrict the claim beyond its expressed and intended meaning.

Further Question Presented

If a writ of certiorari is allowed, plaintiff would present a further and specific reason why the judgment of the Circuit Court of Appeals should be reversed, namely, that according to the interpretation given by that Court, the evidence on the question of infringement shows conclusively that defendants infringe the claim.

This evidence was not mentioned by the Circuit Court of Appeals in its opinion and apparently it was overlooked due to lack of stress in brief and argument. A petition for a rehearing was filed but it was denied *per curiam*. It is submitted that this evidence fully justifies a holding of infringement even according to the interpretation of the claim by the Circuit Court of Appeals for the Second Circuit.

The specific portions of the evidence to be relied upon are referred to in the record as follows:

R. 537, fol. 1609.
R. 541, fols. 1621, 1622, XQ. 104, XQ. 106, XQ. 109.
R. 544, fols. 1630, 1631.
R. 171-172, fols. 513-515.
R. 188-189, fols. 564-566.
R. 202, fols. 605-606.
R. 223-224, fols. 668-671.
R. 233-234, fols. 699-701.
R. 792-793, fols. 2375-2377.

The foregoing testimony is believed to show conclusively that defendants actually hold their needles off to one side of the run, and this Honorable Court will be asked to consider this evidence on the question of infringement if a writ of certiorari is granted.

Respectfully submitted,

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